

REMARKS

Favorable reconsideration of this application in light of the following discussion is respectfully requested.

Claims 15-63 are presently active in this case.

The outstanding Office Action rejected Claims 15-21 and 22-32 under 35 U.S.C. §103(a) as unpatentable over Park (U.S. Patent No. 5,627,579) in view of Boys (U.S. Patent No. 6,314,094). Claims 40, 50 and 53 were rejected under 35 U.S.C. §103(a) as unpatentable over Park in view of Boys and further in view of Lyons (U.S. Patent No. 6,282,412). Claims 57-63 were rejected under 35 U.S.C. §103(a) as unpatentable over Park in view of Boys and further in view of Lyons.

First, Applicant wishes to thank Examiner Perez for the courtesy of an interview granted to Applicant's representative on June 28, 2005, at which time the outstanding issues in this case were discussed. Arguments similar to the ones developed hereinafter were presented and the Examiner indicated that in light of the arguments he would reconsider the outstanding grounds for rejection upon formal submission of a response.

In response to the rejection of Claims 15-21 and 22-32 under 35 U.S.C. §103(a) over Park in view of Boys, Applicant respectfully requests reconsideration of this rejection and traverses the rejection.

Briefly recapitulating, Applicant's independent Claim 15 relates to a mobile device, including a receiver configured to receive program-accompanying digital data; a position locating module configured to determine a current geographic position of the mobile device; a filter module configured to filter location-specific information from the program-accompanying digital data based on the current geographic position; and a communications module configured to transmit data from the mobile device to a service center based on the location specific information. As explained in Applicant's Specification at page 2, lines 1-28

with corresponding Figure 1, Applicant's invention improves upon conventional mobile devices because the user can define by an user profile certain categories or subject areas he is interested in, so that location-specific information on these categories or subject areas can be filtered out.

Turning now to the applied references, Park discloses a vehicle information device for showing direction and distance of travel to a designated geographic location. Park, however, fails to teach or suggest Applicant's claimed communication module configured to transmit data from the mobile device to a service center based on the location-specific information, wherein the location-specific information is based on the current geographic position. In particular, and as acknowledged by the outstanding Office Action,¹ Park fails to teach or suggest the claimed communication module configured to transmit data from the mobile device to a service center based on the location-specific information.

The outstanding Office Action rejects Applicant's Claims 15-21 and 22-32 based on the proposition that Boys discloses the above feature,² and that it would have been obvious to modify Park by importing this feature from Boys to arrive at Applicant's claimed invention. Applicant respectfully submits, however, that Boys fails to disclose the above feature related to a communication module configured to transmit data from the mobile device to a service center, based on the location-specific information.

The outstanding Office Action relies on Boys at column 2, lines 48-65. This passage of Boys recites that an internet-capable radio selects one of the stored hyperlinks chosen by the user and connects the radio to the server addressed by the hyperlink. Additionally, at column 4, lines 15-53, Boys teaches that a directory server stores hyperlinks to access broadcast servers. Accordingly, Applicant disagrees with the outstanding Office Action, in which Boys teaches means for "indicating the transmission of data from the mobile device to

¹ See outstanding Office Action at page 3, lines 4-6.

² See outstanding Office Action from page 3, lines 7-12.

a broadcast center as related to its geographical position.”³ Reading Boys, a person of ordinary skill in the art would understand that a hyperlink location *is not* data transmitted from the mobile device to a service center, based on the location-specific information.⁴ Hyperlinks do not indicate a geographical position of a broadcast center nor does a hyperlink represent geographic and/or location-specific information. A hyperlink provides a name or a uniform resource locator (URL) for referencing (addressing) the broadcast server within a communication network, specifically within the world wide web of the Internet. Accordingly, the Internet radio accessing hyperlink locations of servers in Boys *is not* a communication module configured to transmit data from the mobile device to a service center, based on the location-specific information, as would be required to meet Applicant's claimed feature.

Therefore, even if Park and Boys could be combined, the combination fails to teach every element of the claimed invention. Accordingly, Applicant respectfully traverses, and requests reconsideration of, this rejection based on these patents.⁵

Further, Applicant respectfully traverses the obviousness rejection based on Park and Boys patents because there is insufficient evidence for a motivation to modify Park's vehicle information device to display information on direction and distance of the current vehicle position to a designated point of interest,⁶ by incorporating Boys' Internet radio terminal to access internet broadcast servers for radio data streaming,⁷ for the following reasons.⁸

³ See outstanding Office Action from page 3, lines 10-12.

⁴ See Boys, for example, at column 8, lines 24-30.

⁵ See MPEP 2142 stating, as one of the three "basic criteria [that] must be met" in order to establish a *prima facie* case of obviousness, that "the prior art reference (or references when combined) must teach or suggest all the claim limitations," (emphasis added). See also MPEP 2143.03: "All words in a claim must be considered in judging the patentability of that claim against the prior art."

⁶ See Park in the Abstract.

⁷ See Boys in the Abstract.

⁸ See MPEP 2143.01 stating "[o]bviousness can only be established by combining or modifying the teaching of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art," (citations omitted). See also MPEP 2144.08 III stating that "[e]xplicit findings on motivation or suggestion to select the claimed invention should also be articulated in order to support a 35 U.S.C. 103 ground of rejection.

The outstanding Office Action states that the proposed modification would have been obvious "to implement the system as taught by Park with the teachings of Boys in order to render a user with accurate and efficient delivery of multimedia services."⁹ The record, however, fails to provide the required *evidence* of a motivation for a person of ordinary skill in the art to perform such modification. While Boys may provide a reason for using hyperlinks to connect to Internet broadcast servers in an internet-capable radio, Boys fails to suggest why a person of ordinary skill in the art would be motivated to incorporate such a feature in a vehicle information device to collect specific geographic information from FM voice broadcast such as disclosed in Park. In particular, Boys uses the hyperlinks and the communication port in order to access different broadcast servers.¹⁰ Boys, however, does not suggest that hyperlinks would work in a travel information device receiving data from satellites and FM radio signals. Boys does not state that the travel information device needs "means to communicate requests over Internet-based broadcast entities from the Internet-capable radio receiver."¹¹

In addition, Park is not concerned with requesting access to Internet-based broadcasting entities for radio data streaming. Instead, Park is concerned with receiving GPS signals and signal data packets from a conventional FM radio signal.¹² Park states that its structure already achieves the goal of presenting distance and relative direction of travel from the current vehicle location to the geographic point of interest.¹³ Park does not suggest that further improvement is desired, nor that another feature should be added to further improve the travel information system. In particular, Park does not suggest adding hyperlink addresses for servers, such as those disclosed in Boys.

. . . Conclusory statements of similarity or motivation, without any articulated rational or evidentiary support, do not constitute sufficient factual findings."

⁹ See outstanding Office Action at page 3, lines 13-16.

¹⁰ See Boys at column 4, lines 15-53 and in corresponding Figure 4.

¹¹ See outstanding Office Action at page 3, lines 8-10.

¹² See Park, for example, at column 3, lines 42-48 and at column 4, lines 12-19.

¹³ See Park, for example, in the Abstract.

Park and Boys, therefore, do not provide the motivation to perform the proposed modification of Park. In other words, an attempt to bring in the isolated teaching of Boys' communication port accessing servers with hyperlink addresses into Park's travel information system would amount to improperly picking and choosing features from different references without regard to the teachings of the references as a whole.¹⁴ While the required evidence of motivation to combine need not come from the applied references themselves, the evidence must come from *somewhere* within the record.¹⁵ In this case, the record fails to support the proposed modification of Park.

The U.S. Court of Appeals for the Federal Circuit recently vacated a rejection under 35 U.S.C. §103(a) based on similar grounds.¹⁶ In vacating a rejection, the Court stated:

The record reflects that the examiner and the Board have managed to find motivation for substituting one type of memory for another *without providing a citation of any relevant, identifiable source of information justifying such substitution*. The statements made by the Examiner, upon which the Board relied, amount to no more than conclusory statements of generalized advantages and convenient assumptions about skilled artisans. At least under the MPEP then in effect, such statements and assumptions are inadequate to support a finding of motivation, which is a factual question that cannot be resolved on "subjective belief and unknown authority." *Lee*, 277 F.3d at 1344. Under such circumstances, with respect to core factual findings, "the Board *must point to some concrete evidence in the record in support*" of them, rather than relying on its assessment of what is "well recognized" or what a skilled artisan would be "well aware." (emphasis added)

Furthermore, Applicant respectfully submits that it is not clear from the record how Boys' requesting audio data streams through hyperlinks from broadcast servers¹⁷ could be

¹⁴ See *In re Ehrreich* 590 F.2d 902, 200 USPQ 504 (CCPA, 1979) (stating that patentability must be addressed "in terms of what would have been obvious to one of ordinary skill in the art at the time the invention was made in view of the sum of all the relevant teachings in the art, not in view of first one and then another of the isolated teachings in the art," and that one "must consider the entirety of the disclosure made by the references, and avoid combining them indiscriminately.")

¹⁵ *In re Lee*, 277 F.3d 1338, 1343-4, 61 USPQ2d 1430 (Fed. Cir. 2002) ("The factual inquiry whether to combine references ... must be based on objective evidence of record. ... [The] factual question of motivation ... cannot be resolved on subjective belief and unknown authority. ... Thus, the Board must not only assure that the requisite findings are made, based on evidence of record, but must also explain the reasoning by which the findings are deemed to support the agency's conclusion").

¹⁶ *In re Beasley*, 2004 U.S. App. LEXIS 25055 (Fed. Cir. December 2004)

¹⁷ See Boys, for example, at column 4, lines 40-45.

incorporated into Park's vehicle information device receiving conventional FM broadcasts or receiving GPS signals.¹⁸ Under such a modification, Boys' data streams accessed by hyperlinks would have to be accessed from either conventional FM radio signal or GPS satellite reception. Such modification would require a substantial reconstruction or redesign of the elements of Park, and would change the basic principle of operation of the Park. There is no evidence that a person of ordinary skill in the art would be motivated to perform such changes and redesign.¹⁹

In rejecting a claim under 35 U.S.C. § 103(a), the USPTO must support its rejection by "substantial evidence" within the record,²⁰ and by "clear and particular" evidence²¹ of a suggestion, teaching, or motivation to combine the teachings of different references. As discussed above, there is no substantial evidence, nor clear and particular evidence, within the record of motivation for modifying Park by incorporating Boys' internet capable radio for accessing broadcast servers. Without such motivation and absent improper hindsight reconstruction,²² a person of ordinary skill in the art would not be motivated to perform the proposed modification, and Claims 15-21 and 22-32 are believed to be non-obvious and patentable over the applied references.

Applicant further respectfully submits that the applied references Park and Boys do not teach all the features of Applicant's dependent claims. The outstanding Office Action

¹⁸ See Boys, for example, at column 4, lines 19 and in Figures 1 and 2 (elements 20 and 50).

¹⁹ See In re Ratti, 270 F.2d 810, 813, 123 USPQ 349, 352 (reversing an obviousness rejection where the "suggested combination of references would require a substantial reconstruction and redesign of the elements shown in [the primary reference] as well as a change in the basic principle under which the [primary reference] construction was designed to operate.")

²⁰ In re Gartside, 203 F.3d 1305, 53 USPQ2d 1769 (Fed. Cir. 2000) (holding that, consistent with the Administrative Procedure Act at 5 USC 706(e), the CAFC reviews the Board's decisions based on factfindings, such as 35 U.S.C. § 103(a) rejections, using the 'substantial evidence' standard because these decisions are confined to the factual record compiled by the Board.)

²¹ In re Dembiczak, 175 F.3d 994, 999, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999) ("We have noted that evidence of a suggestion, teaching, or motivation to combine may flow from the prior art references themselves, the knowledge of one of ordinary skill in the art, or, in some cases, from the nature of the problem to be solved, although 'the suggestion more often comes from the teachings of the pertinent references.' The range of sources available, however, does not diminish the requirement for actual evidence. That is, the showing must be clear and particular." (emphasis added).

²² See MPEP 2141, stating, as one of the tenets of patent law applying to 35 USC 103, that "[t]he references must be viewed without the benefit of impermissible hindsight vision afforded by the claimed invention."

acknowledges that Park does not explicitly disclose the mobile device to be a portable mobile device,²³ as claimed by Applicant's dependent Claims 33, 36 and 57. The outstanding Office Action teaches that Figures 2-3 of Park depict a portable housing configured to support the receiver, the position locating unit and the processor.²⁴ Park explicitly states that Figure 2 is a block diagram of the travel information device.²⁵ The block diagram of Figure 2 in Park does not provide any information on a portable housing. Furthermore, Park explicitly states that Figure 3 illustrates the front panel controls and display of the travel information device as viewed by the operator of the vehicle.²⁶ Accordingly, Figure 3, shows only a part of the device and does not disclose a portable housing. For reasons mentioned above, it is believed that it is improper to combine the references Park and Boys. Furthermore, contrary to the Examiner's opinion, Boys does not teach a portable device but an Internet radio device for in-dash mounting in a car.²⁷ Devices configured for in-dash mounting do not have their own power supply and are thus not suitable for portable use. Accordingly, Applicant traverses the rejection of Applicant's dependent Claims 33, 36 and 37 and requests reconsideration of the rejection.

In response to rejections of Claims 40, 50 and 53 as well as Claims 57-63 under 35 U.S.C. §103(a) over Park in view of Boys and further in view of Lyons, Applicant traverses the rejection, since Lyons does not overcome the above mentioned deficiencies of the references Park and Boys to reject Applicant's independent Claims 15 and 22. Accordingly, Applicant respectfully requests reconsideration of these rejections.

Consequently, in view of the present Request for Reconsideration, no further issues are believed to be outstanding in the present application, and the present application is

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²⁴ See outstanding Office Action on page 6, lines 8-9.

²⁵ See Park at column 2, lines 46-47.

²⁶ See Park at column 2, lines 48-51.

²⁷ See Boys at column 4, lines 34-36; column 5, lines 59-67.

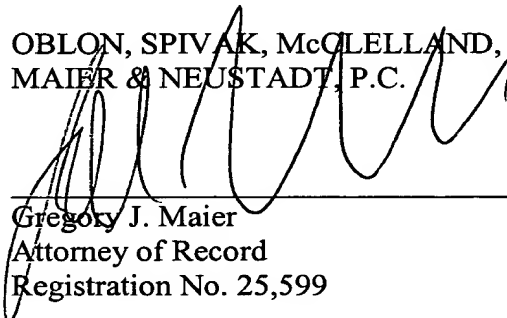
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believed to be in condition for formal Allowance. A Notice of Allowance for Claims 15-63 is earnestly solicited.

Should the Examiner deem that any further action is necessary to place this application in even better form for allowance, the Examiner is encouraged to contact Applicant's undersigned representative at the below listed telephone number.

Respectfully submitted,

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